

45198.00013.RCE  
PatentIN THE UNITED STATES PATENT AND TRADEMARK OFFICEApplicants: Erion *et al.*

Serial No.: 09/518,501

Filed: March 3, 2000

Title: NOVEL PHOSPHORUS-CONTAINING  
PRODRUGS

Group Art Unit: 1624

Examiner: McKenzie, T.

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450**INTERVIEW SUMMARY**

On September 10, 2003, Examiner McKenzie and his supervisor Mukund Shah conducted an in-person interview with Applicants' attorney Jessica Wolff and Dr. Mark Erion with regard to Application No. 09/518,501. Also present telephonically were Applicants' attorney Diana Bush and Applicants' patent agent, Cynthia O'Donohue. Application No. 09/747,182 was also discussed.

In regard to this Application, the following topics were discussed:

1. Examiner's indefiniteness, lack of written description, and non-enablement rejections based on the term "M is selected from the group that attached to  $\text{PO}_3^{2-}$ ,  $\text{P}_2\text{O}_6^{3-}$ ,  $\text{P}_3\text{O}_9^{4-}$  or  $\text{P}(\text{O})(\text{NHR}^6)\text{O}^-$  is a biologically active agent but is not an FBPase inhibitor" in claims 1-3, 7, 9-18, 20-46, 48-53, 150-157, 165-166, and 171-173.

Applicants described the technology of the invention, data, and how the invention is applied. The Examiners expressed concerns regarding PTO policy on functional language in light of the *University of Rochester Cox 2* inhibitor district court decision.

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Applicants distinguished that case and emphasized the amount of data taught in the current application. Examiner McKenzie expressed that he has no doubt that there is allowable subject matter, but that it is more an issue of the breadth of the claims. Examiner Shah indicated that if the Applicants submitted evidence and arguments that the claims do meet the requirements of definiteness, written description, and enablement, he will further evaluate the functionality issue and ascertain if quality control would consider these claims as meeting the functional guidelines based on the evidence and arguments presented.

2. Examiner's indefiniteness, lack of written description, and non-enablement rejections for the term "prodrug" in claims 1-18, 20-46, 48-57, 150-157, and 165.

Applicants discussed that many issued patents use this language in the claims. Examiner Shah indicated that this language does meet the requirements for definiteness, written description, and enablement.

3. Examiner's indefiniteness rejection of claims 155-157 and 166 based on the term "oxidizing agent."

Examiner Shah indicated that this language does meet the requirement of definiteness.

Respectfully submitted,

Dated: 12/16/03

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